

REMARKS

Claims 1-19 are pending in the present application. Reconsideration of the pending claims is requested in view of the following explanations.

Applicants note with appreciation the Examiner's withdrawal of previous objections to claims 4 and 11 in view of the Amendment filed on October 5, 2007.

Claims 1, 9, 10 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,771,287 ("Gilley"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

Independent claim 1 recites, in relevant parts, "a plurality of modules including a microprocessor and at least one storage module for storing code and data for the microprocessor, at least one of the modules storing **a serial number of the at least one module** in a non-exchangeable manner; an arrangement for storing a code number, **the code number being obtained from the serial number by using an encryption method**, and for storing information required to calculate the serial number from the code number, wherein the microprocessor is adapted to calculate a serial number from the code number on the basis of the information, to compare the calculated serial number to the stored serial number, and to execute or not execute at least part of the code as a function of a result of the comparison." Claim 10 recites substantially similar method features as the above-recited features of claim 1.

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6 In the Office Action, the Examiner contends that the “authentication code” in Gilley is equivalent to the “serial number” recited in claim 1. See Office Action, page 3, lines 9 to 21 (the Examiner contends that Gilley teaches that “present authentication code is then compared . . . to the factory calculated and set authentication code,” and that this disclosure in Gilley satisfies the claimed feature of “compar[ing] the calculated serial number to the stored serial number” recited in claim 1). Additionally, in support of the assertion that Gilley teaches the claimed feature of “the code number being obtained from the serial number by using an encryption method,” the Examiner cites col. 5, l. 65 to col. 7, l. 1 of Gilley as disclosing a “secured encryption algorithm is used with the operation mode code and the secret key to create the authentication code,” which means the Examiner is equating the “authentication code” of Gilley with “serial number” recited in claim 1. See Office Action, page 3, lines 3 to 8. However, even if one assumed for the sake of argument that the Examiner is correct in asserting that the cited section of Gilley disclose that a secured encryption algorithm is used with the operation mode code and the secret key to create the authentication code, with which assumption Applicants do not agree, the cited sections of Gilley still do not disclose or suggest the “code number being obtained from the serial number by an encryption method”; instead, Gilley merely discloses that the authentication code, which the Examiner equates with the claimed “serial number,” is created by an encryption method using the operation mode code and the secret key, which is not at all equivalent to obtaining the code number from the serial number by an encryption method. Indeed, any close reading of Gilley will reveal that the operational mode code refers to a numerical value correlated to a particular operation mode, and the secret key refers to a randomly generated number, none of which results from encrypting the authentication code. Therefore, Gilley cannot anticipate claims 1 and 10 under 35 U.S.C. § 102(b).

For at least the foregoing reasons, claims 1 and 10, as well as their dependent claims 9 and 17, are patentable over Gilley. Withdrawal of the anticipation rejection is respectfully requested.

Claims 2-8, 11-16, 18 and 19 were rejected under 35 U.S.C. § 103(a) as obvious over Gilley in view of U.S. Patent No. 6,026,293 (“Osborn”). Applicants respectfully submit that the rejection should be withdrawn, for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28

U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 2-8, 11-16, 18 and 19 depend from claim 1 or claim 10. As noted above, Gilley fails to anticipate parent claims 1 and 10. In addition, Osborn clearly does not overcome the deficiencies of Gilley as applied against claims 1 and 10. Therefore, even if one assumes for the sake of argument that there is some motivation to combine the teachings of Osborn and Gilley (which is not conceded), the combination clearly fails to render dependent claims 2-8, 11-16, 18 and 19 obvious.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that all pending claims 1-19 of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully Submitted,
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